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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,371	04/21/2005	Desmond John Best	P33127USw	8693
23347 7590 02/28/2008 GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B475 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398				
EXAMINER JARRELL, NOBLE E				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
02/28/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/532,371

Applicant(s)

BEST ET AL.

Examiner

Noble Jarrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/22/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/08)
Paper No(s)/Mail Date 4/21/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group I in the reply filed on 1/22/2008 is acknowledged.

Priority

2. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country. Priority for the elected group goes back to United Kingdom applications 0303467.5 (filed 2/14/2003) and 0224558.7 (filed 10/20/2002).

Claim Objections

3. Claims 1 and 2 are objected to because of the following informalities: Claims 1 and 2 contain non-elected subject material. Appropriate correction is required. A second reason claim 2 is objected to because of the teaching in MPEP 2173.05(s): 'Incorporation by reference to a specific figure or table "is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted).' Claim 2 refers to figures E1-E272 in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1, 3, and 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pharmaceutically acceptable salts and parent compounds of formula I of the elected group, does not reasonably provide enablement for solvates of formula I. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. While applicants are enabled for parent compounds and pharmaceutically acceptable salts of compounds of formula I, applicants are not enabled for the preparation of solvates of formula I. Vippagunta et al. (*Advanced Drug Delivery Reviews*, **2001**, *48*, 3-26) show that solvate formation is unpredictable due to the unique molecular nature of each compound in a related series (page 18, section 3.4). Thus, solvate formation is unpredictable.

The factors to be considered in determining whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir., 1988). The court in *Wands* states, "Enablement is not precluded by the necessity for some experimentation, such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations" (*Wands*, 8 USPQ2d 1404). Among these factors are: (1) the nature of the invention; (2) the breadth of the claims; (3) the state of the prior art; (4) the predictability or unpredictability of the art; (5) the relative skill of those in the art; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

Consideration of the relevant factors sufficient to establish a *prima facie* case for lack of enablement is set forth herein below:

(1) The nature of the invention and (2) the breadth of the claims:

The claims are drawn to compounds of formula I where a piperazine ring is indirectly attached to a phenyl ring through a carbonyl group. The phenyl ring has an ether group attached to its *para* position.

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(3) The state of the prior art and (4) the predictability or unpredictability of the art:

Vippagunta et al. show that solvate formation is unpredictable.

(5) The relative skill of those in the art:

One of ordinary skill in the art is familiar with the synthetic techniques shown in specification.

(6) The amount of direction or guidance presented and (7) the presence or absence of working examples:

The specification has provided guidance for preparation of parent compounds of formula I and pharmaceutically acceptable salts thereof.

However, the specification does not provide guidance for preparation of solvates of formula I.

(8) The quantity of experimentation necessary:

Applicants would have to test each compound prepared separately in different solvent systems to see what type of solvate(s) form.

Considering the state of the art as discussed by the references above, particularly with regards to claims 1, 3, and 7 and the high unpredictability in the art as evidenced therein, and the lack of guidance provided in the specification, one of ordinary skill in the art would be burdened with undue experimentation to practice the invention commensurate in the scope of the claims.

6. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for *in vitro* testing of histamine H₃ receptors, does not reasonably provide enablement for the *in vivo* use of compounds of formula I as histamine H₃ receptors. The specification does not enable any person skilled in the art to which it pertains, or with which it is

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most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The factors to be considered in determining whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir., 1988). The court in *Wands* states, "Enablement is not precluded by the necessity for some experimentation, such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations" (*Wands*, 8 USPQ2d 1404). Among these factors are: (1) the nature of the invention; (2) the breadth of the claims; (3) the state of the prior art; (4) the predictability or unpredictability of the art; (5) the relative skill of those in the art; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary.

Consideration of the relevant factors sufficient to establish a *prima facie* case for lack of enablement is set forth herein below:

(1) The nature of the invention and (2) the breadth of the claims:

The claims are drawn to treatment of neurological disorders using compounds of formula I.

(3) The state of the prior art and (4) the predictability or unpredictability of the art:

Onodera et al. ("Histamine H3 antagonists as potential therapeutics in the CNS", eds, Leurs and Timmerman, pages 255-267, **1998**, reference 13 of the IDS) show that even though some H3 antagonists work in vitro, they do not work in vivo because they have difficulty crossing the blood-brain barrier (page 263, first paragraph).

(5) The relative skill of those in the art:

One of ordinary skill in the art is a scientist familiar with the assay techniques described in the specification.

(6) *The amount of direction or guidance presented and (7) the presence or absence of working examples:*

The specification has provided guidance for *in vitro* testing of prepared compounds, but not *in vivo* testing and use of prepared compounds.

(8) *The quantity of experimentation necessary:*

In order to prove that the prepared compounds work *in vivo*, applicants need to show that these compounds are safe and efficacious, and are able to cross the blood-brain barrier. The compounds should be able to cross the blood-brain barrier because claim 7 cites the treatment of neurological disorders.

Considering the state of the art as discussed by the references above, particularly with regards to claim 7 and the high unpredictability in the art as evidenced therein, and the lack of guidance provided in the specification, one of ordinary skill in the art would be burdened with undue experimentation to practice the invention commensurate in the scope of the claims.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2 and 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What specific neurological diseases are being treated through modulation of histamine H3 receptors? Applicants cite "Alzheimer's disease and related neurodegenerative disorders" on page 18 of the specification. What disorders are considered related to Alzheimer's disease?

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9. Claim 2 recites the limitation "formula E1-E272". There is insufficient antecedent basis for this limitation in the claim because there is no compound of any of these formulae listed in claim 1.

10. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the specific compounds that formulae E1-E272 refer to. Even though these formulae are listed in the specification, claim 2 must stand independent of the specification.

Allowable Subject Matter

11. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Noble Jarrell whose telephone number is (571) 272-9077. The examiner can normally be reached on M-F 7:30 A.M - 6:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/
Examiner, Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner
Art Unit 1624**